

REMARKS

Claims 1, 8 and 10 are have been amended for clarity. Entry of the Amendment is in order because it does not require consideration of new issues or a new search. The Amendment was not made previously because the errors corrected thereby were not realized by Applicant.

Applicant traverses the rejection of claims 1-6 and 8-14 under 35 U.S.C. 103 (a) as being unpatentable over Balsom, U.S. Patent 5,568,455, in view of applicant's admitted prior art. Applicant can not agree with the statement in the clause bridging pages 2 and 3 of the Office Action that Balsom discloses a reader configured to read data signals from bar code 30 of the cartridge loaded in the reader and print indications derived from the data signals. Further, Applicant does not agree that independent claims 1, 12 and 14 differ from Balsom only by requiring a programmable storage medium having cartridge information affixed to the cartridge.

The Office Action says to see Figures 3 and 4, and col. 6, line 12+ to find a disclosure in Balsom of a reader configured to read data signals from bar code 30 of a cartridge loaded in a reader and print indications derived from the data signals. Applicant notes that in Balsom, a preprinted label including bar code 30 and alphanumerical code 20 is affixed to a cartridge. The bar code 30 represents the alphanumerical code (see col. 1, lines 24-27; and col. 6, lines 6-9). None of Figure 3, Figure 4 or col. 6, line 12+ indicates that indications derived from the data signals which the Examiner refers to as coming from bar code 30 are printed. Instead, these portions of the '455 reference indicate the alphanumerical code indicated by the bar code is read from the bar code on the label and thence is written to an optical disk in the cartridge carrying the label with the alphanumerical and optical code on its exterior. The label with the alphanumerical code 20 and bar code 30 is apparently pre-prepared and then externally affixed to the cartridge to the (see col. 1, lines 18-20; and col.5, lines 29-34). Each time a new cassette is ordered or consumed, the alphanumerical code 20 is incremented (see. col. 1, lines 21-24). Presumably, the label is prepared in accordance with the method and apparatus disclosed in Balsom 5,592,596, the reference the Examiner previously relied on to reject the claims. The Examiner agrees the '596 reference is not relevant to the claimed subject matter since the '596 reference is no longer being applied against the claims. Col. 6, line 12+ of the '455 patent says that after the label with alphanumerical code 20 and bar code 30 has been put on the cartridge the

bar code is scanned and written to a storage device, for example, a hard disk. From the hard drive, the signal written into the hard drive from the bar code is then read and written into the optical disk in the cartridge. Hence, the information in bar code 30 goes into the optical disk carried by the cartridge having the label carrying the bar code. There is nothing in the '455 reference saying the signal from the bar code is ever transferred to a printer. As a matter of fact, attorney for Applicant could find no mention of a printer that responds to a signal read from bar code 30 in the '455 patent.

Based on the foregoing, the rejection of independent claims 1 and 14 is wrong. Claim 1 differs from the '455 reference by defining a reader to read data signals describing a data storage device and to print information derived from the data signals. Claim 14 differs from '455 by requiring the step of responding to such data signals as stored in a memory of a reader by printing the information in such a way that the printed information can be put on data storage device. The admitted prior art fails to disclose such a reader or printer. The rejection of independent claims 1 and 14 is thus incorrect.

The method of independent claim 12 is entirely different from any method the '455 reference and the admitted prior art discloses. Claim 12 is directed to obtaining information about a high-capacity data storage medium carried by a cartridge having a low capacity memory. The information is obtained without reading the high-capacity storage medium. In particular, claim 12 includes the step of responding to signals read by a transducer, wherein the signals are indicative of information stored in a low capacity memory. As a result of the response to the signals read by the transducer, exterior human readable material commensurate with the information stored in the low capacity memory is applied to the cartridge. Presumably, the position of the Examiner is that bar code 30 of the '455 reference is similar to the low capacity memory. However, as previously pointed out, the information read from bar code 30 is initially stored in a memory such as a hard disk. From the hard disk the information is read into the optical disk located in the cartridge carrying the label. Hence, the steps of claim 12 are exactly the opposite of the steps of the '455 reference. Consequently one of ordinary skill in the art would not have modified the '455 reference in view of the admitted prior art to arrive at the combination of steps that claim 12 defines.

Applicant can not agree with many of the comments in the Office Action concerning the dependent claims. The Examiner says the '455 reference includes port 47 with a printer that prints information onto the cartridge. He cites col. 6, lines 25-29 of the reference for this point. Applicant notes that claims 2 and 9, about which the Examiner makes this comment, require the printer to print the signal information directly onto the cartridge, a feature the Office Action does not mention and does not appear to be found in the '455 reference. Further, the '455 reference indicates that reference numeral 47 is associated with an optical disk drive for read and write operations (see col. 3, lines 3 and 4). Applicant is unable to find any mention in col. 6, lines 25-29 of optical disk drive 47 printing information directly onto a cartridge.

The Examiner erroneously says the display of claim 5 can be found in the '455 reference. Claim 5 requires the display to display data items read from the programmable memory; data items are defined in claim 1 as describing the data storage device. While the '455 reference may include a display there is nothing in the reference to indicate data items which are read and describe the data storage device are supplied to the display of the '455 reference. The Examiner is reminded that he has the obligation of showing inherency by scientific reasoning or other evidence. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q. 2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ 2d 1949, 1950-51 (Fed. Circ. 1999). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). See MPEP §2112. The Examiner has failed to make the requisite showing with regard to claim 5.

Entry of the Amendment and allowance are in order.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

LOWE HAUPTMAN GILMAN & BERNER, LLP

A handwritten signature in black ink, appearing to read "Allan M. Lowe", is written over the printed name.

Allan M. Lowe
Registration No. 19,641

USPTO Customer No. 22429
1700 Diagonal Road, Suite 300
Alexandria, VA 22314
(703) 684-1111 AML/iyf/gmj
(703) 518-5499 Facsimile
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